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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/764,110 12/06/96 CHEN

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023913
PFIZER INC
235 E 42ND STREET
NEW YORK NY 10017

HM12/0627

EXAMINER

BERCH, M

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

06/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/764,110

Applicant(s)

CHEN, YUHPYNG L.

Examiner

Mark L. Berch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 8-10, 12-14, 18, 19 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 8-10, 12-14, 18, 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-4, 8-10, 12-14, 18, 25 are rejected under 35 U.S.C. 112, paragraphs 1 and 2, as the claimed invention is not described, or is not described in such full, clear, and exact terms as to enable any person skilled in the art to make and use the same, and/or failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. Specifically:

1. The revised definition of $-CR^1R^2R^{10}$ ring is broader than the specification describes. (Paragraph 1) Page 4 sets forth the $-CR^1R^2R^{10}$ ring as being carbocyclic, and then permits 1-2 atoms to be O/S/NZ³. The new language does not require the $-CR^1R^2R^{10}$ ring to be carbocyclic in the first place, so that it could be e.g. C-bound triazine from the start, not permitted by the specification.
2. Similarly, the specification permits C atom replacement only in 5-8 membered rings. This new language would permits the $-CR^1R^2R^{10}$ ring to be e.g. C-bound azetidine since the $-CR^1R^2R^{10}$ ring is not required to be carbocyclic even before C atom substitution (paragraph 1).

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3. In addition, the provision for replacement with O, S, or NH does not appear to have any function, since these rings are already permitted to have any type of ring atoms. Thus, the purpose of such language is unclear. (paragraph 2)

4. The replacement of thioalkyl with alkylthio is new matter for the reasons set forth previously. Applicant's arguments have been fully considered but they are not persuasive. Applicants now concede that their original argument "does not make sense" but insist that alkylthio was clearly intended. As proof, they note the use of the term "alkoxy" in the same markush group of moieties. The logic of this is not clear to the examiner. If applicants had actually intended mercaptoalkyl, the alkoxy group would still be called alkoxy. In other words, the fact that the alkoxy group was correctly called alkoxy gives no clue as to which of several possibilities was intended for thioalkyl. And the fact that the alkoxy group was named does not mean that the S "homologue" (as applicants call it) was also intended. (Paragraph 1).

5. The addition of CF_3 to the R^4 definition is new matter for reasons set forth previously. Applicant's arguments have been fully considered but they are not persuasive. The main definition does not include this group. The appearance on page 9 only says what it says; it does not say anything beyond that. It provides "specific embodiments". This essentially describes a small genus where R^3 has four values, R^4 has three (including the CF_3), etc. Applicants ask, "since when does a semicolon necessarily mean "and"?" When used in a list, the comma and the semicolon are normally understood as "and". Further, this particular list defines a different variable in each segment, making it clear that this is a genus in which the variables are being defined in sequence. The exact same format is used in the main definition on pages 2-5.

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Each variable choice is separated by a semicolon (see e.g. page 2, lines 25, 27, 31, etc.), with the understanding that the genus is such that it has this definition for A and this definition for B and this definition for D, etc. Page 9 would be read in the same way, a genus in which it has this definition for R³ and that definition for R⁴, etc. Applicants note that the list is incomplete, in that elements A and B are not defined. One of ordinary skill in the art would then have to use the main definitions by default; there is no need to need to repeat the same definitions. (This does not apply to claim 3). (paragraph 1)

6. In claim 25, the first line of the F definition says "at least one" but that is contradicted by the second line which says only one. The overall wording is cumbersome (does "D and E are not N" mean to bar only D = E = N?). Suggested is "provided that either 1) exactly one of D or E is N and F is CHR⁴ or 2) F is NR⁴ and neither C nor D are N."

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

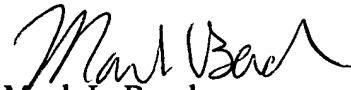
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 708-308-1235.


Mark L. Berch
Primary Examiner
Art Unit 1624

June 22, 2001